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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,760	09/20/2000	Ulrich Priesnitz	GR 98 P 1397 P	8661

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EXAMINER

DYE, RENA

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 04/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/665,760

Applicant(s)

PRIESNITZ ET AL.

Examiner

Rena L. Dye

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Withdrawal of Finality of Rejection***

1. Upon further review of the present claims, the finality of the rejection of the last Office action is withdrawn to require further clarification.

### ***Information Disclosure Statement***

2. The Information Disclosure Statement filed on January 28, 2003 has been received and considered. A copy of the Form PTO-1449 has been included with this Office action.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the recitation of "said second layer being formed of a second material and containing, at least inside said marking face, a second proportion of the dye smaller than said first proportion of dye, said second proportion of dye associated with said second layer being dimensioned to cause a color change upon irradiation with photons" is vague and unclear.

Applicant's claim language does not clearly set forth how one having ordinary skill in the art would utilize the marking face. It is not clear what the relationship is between the first and

Art Unit: 3627

second dyes that would enable the user to notice a change. For example, if the first and second dyes are the same color upon a color change by irradiation with photons, then how is a distinction made? Clarification is requested.

Upon a careful review of Applicant's specification it appears that Applicant's invention is directed to a two-layer sheathing wherein the relatively outer thinner layer has a lesser proportion of dye than the inner layers. The outer layer completely absorbs the incident laser radiation, while the inner layer beneath it performs the protective function, and the marking in the outer layer creates a color contrast against the background of the inner layer. This teaching can be found in Applicant's "Summary of Invention" at page 4, lines 12-19, and does not appear to be directed to a preferred embodiment. Applicant appears to be claiming the invention more broadly than the specification will support, and in a manner which is vague and difficult to understand.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 13-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In claim 13, the recitation of "a sheathing separating an interior from an exterior, and having an exterior layer (*only*), is not clearly supported by the present specification. The present

Art Unit: 3627

specification appears to only support a first and second layer, both containing a proportion of a dye, and not a single exterior layer as set forth in claim 13. Clarification or amendment is requested.

### ***Drawings***

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the recitation of "a sheathing separating an interior from an exterior, and having an exterior layer (*only*), must be shown or the feature canceled from the claims. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,3,10,11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler (US 4,865,198).

Butler teaches a sheathing article or overwrapping packaging material comprising an external layer of flexible transparent or translucent overwrap plastic film. In all embodiments of the invention the overwrap film must have sufficient transparency or translucency so that a

Art Unit: 3627

pattern disposed on its inner surface is visible through the film. Preferred films include single or multiple layer films comprising polyolefins (thermoplastic material). The chemical nature of the film is not critical as long as it (1) has sufficient film integrity for its intended protective use, (2) provides a surface having appropriate ink affinity characteristics, and (3) is essentially transparent, or sufficiently conductive with respect to the energy source used to vaporize or activate the underlying coating or pigments. With appropriate selection of energy type and level, wavelength and the link, the process is amenable to any of the optically transparent overwrap films used commercially (column 2, lines 12-39). The overwrapped package includes a package of substrate 3 (first layer) which can be constructed from any suitable packaging material such as paper, metal, glass, plastic or the like with a heat-labile ink, pigment or adhesive coating 4 (second layer). The heat-labile ink can be any ink that can be vaporized by an energy source such as light provided from a pulsed laser. The ink can be thermotropic in nature so that direct heat application causes a change in color (column 2, lines 40-55).

Butler fails to specifically teach a dye provided in both the first (3) and second layers (4). The first and second layers being formed of the same material are within the scope of the teachings of the reference. It would have been obvious to one having ordinary skill in the art to have also included a dye in the first layer (3) to have created a contrast in layer (4) after removal of the overwrapping. Thus any unauthorized movement of the overwrapped layer is clearly visible as an ink pattern which is deposited on the overwrap layer will not be in register with the de-inked surface of the package substrate, while that which is left behind will show the color contrast between the first and second layers, the background of the color from layer 3 showing

Art Unit: 3627

through the de-inked area. Such a color contrast is deemed to be an obvious design choice such that any color pigment, or amount of pigment thereof, could be used in any of the layers.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-9 and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler (US 4,865,198) in view of Bonkowski et al. (US 6,031,457).

Butler has been previously discussed and fails to specifically teach graphite as the dye material.

Bonkowski teaches a substrate layer or film which can be printed using a laser or other types of printers. The printing can be composed of any printing materials such as paint, ink or graphite compositions (column 5, lines 19-57).

Since Bonkowski teaches that graphite is a known dye or ink for use in printing with a laser, it would have been obvious to one having ordinary skill in the art to have used graphite in the ink or pigment layer of Butler. The proportion of dye in each of the layers would have been an obvious design choice based upon the desired visual appearance.

With respect to thickness, one having ordinary skill in the art would have known how to have varied the thickness based upon the desired degree of strength and barrier property.

***Response to Arguments***

10. Applicant's arguments filed on February 3, 2003 have been fully considered but they are not persuasive.

Applicant's arguments have been carefully considered, however, the Examiner has carefully reviewed the claims and the above new grounds of rejections have been made in view of the Examiner's findings.

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

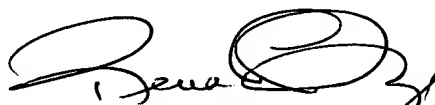
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rena L. Dye whose telephone number is 703-308-4331. The examiner can normally be reached on Monday-Thursday 8:30 AM - 7:00 PM EST.



Art Unit: 3627

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703-308-5183. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Rena L. Dye  
Primary Examiner  
Art Unit 3627

R. Dye  
April 12, 2003